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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/843,181      04/26/2001      Chris Sikorski      CER-298      9166

20311      7590      01/24/2003

MUSERLIAN AND LUCAS AND MERCANTI, LLP  
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NEW YORK, NY 10016

EXAMINER
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WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 01/24/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/843,181

Applicant(s)

SIKORSKI ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendment filed October 22, 2002 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

- (A) Claims 6 and 8-11 have been amended.
- (B) Comments regarding Art Rejection have been provided drawn to
  - (a) 112, 2<sup>nd</sup> paragraph rejection, which has been withdrawn;
  - (b) 103(a) rejections, which have been maintained for the reasons of record;
  - (c) Substantial duplicate claims, which has been withdrawn.

2. Claims 1-18 are pending in the case.

3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al (US Patent No. 6,153,746) in view of Walsh (US Patent No. 5,980,971) for the reasons disclosed on pages 3 and 4 of the Office Action mailed July 2, 2002.

5. Applicant's arguments filed October 22, 2002 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Shah et al and Walsh patents do not contain analogous subject matter since the Walsh patent doesn't dry cyclodextrins. This argument is not persuasive since both patents uses drum drying technique to dry their perspective products. Since the Shah et al patent is silent with regard to the particular type of drum dryer, the Walsh patent shows that both types of drum drying apparatus are effective in drying the product to the desired size. The Walsh patent teaches that either a single or double drum dryer would be effective in controlling the thickness of the product by changing the settings of the drum dryer gap between the rolls.

Applicants further argue that the broad range of product size taught in the Walsh patent does not render obvious the much narrower particle size of the present invention. However, this argument is not persuasive since the Walsh patent discloses particle sizes that cover the particle sizes set forth in the instant claims and teaches that the

drum dryers can be adjusted to produce a particular size product. No more than routine skill is involved in adjusting settings of the drum dryer gap between the rolls to produce a desired particle size, which one would expect the artisan to carry out in order to produce the optimum product. Furthermore, particle size does not render a process for producing a chemical composition patentable when the range is embraced by the prior art, in the absence of evidence of superior results. *In re Reven* (CCPA 1968) 390 F2d 997, 156 USPQ 679. For example, see column 6, 5<sup>th</sup> paragraph of the Mandell et al (US Patent No. 6,229,062), which is not used in the rejection of the claims, shows that cyclodextrins having particle sizes of about 25 to about 200 microns is well known in the art. Accordingly, the rejection of the claims as being unpatentable over the Shah et al and Walsh patents is maintained for the reasons of record.

6. Claims 7-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Shah et al and Walsh patents as applied to Claims 1-5 above, and further in view of Giacobello (US Patent No. 4,127,944) for the reasons set forth on pages 4 and 5 of the Office Action mailed July 2, 2002.

7. Applicant's arguments filed October 22, 2002 have been fully considered but they are not persuasive. Arguments presented in the above rejection for the Shah et al and the Walsh patents are also applied to this rejection of the claims. Applicants further argue against the use of the Giacobello patent in the rejection of the claims on the ground that the instant invention does not utilize a vacuum chamber to surround a drum dryer. This argument is not persuasive since the claims as currently written do not exclude the use of other procedures along with the instant claims, including utilizing a vacuum chamber. Applicants also argue that the Giacobello patent does not render obvious the specific particle size distribution as claimed. This argument is not persuasive since particle size does not render a process for producing a chemical composition patentable when the range is embraced by the prior art, in the absence of evidence of superior results. *In re Reven* (CCPA 1968) 390 F2d 997, 156 USPQ 679. Accordingly, the rejection of the claims as being unpatentable over the Shah et al and

Walsh patents, further in view of the Giacobello patent, is maintained for the reasons of record.

8. Claims 12-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Majid et al (US Patent No. 5,070,081) in view of Shah et al (US Patent No. 6,153,746) for the reasons already of record on pages 5 and 6 of the Office Action mailed July 2, 2002.

9. Applicant's arguments filed October 22, 2002 have been fully considered but they are not persuasive. On page 7, lines 5 and 4, Applicants argue that the Majid patent does not mention cyclodextrins. The Examiner points Applicants to the title of the Majid et al patent, which is "Inclusion Complexes of Cyclodextrins by Agglomeration". The arguments presented by Applicants against this rejection are based on process limitations. As indicated in the original rejection of the claims in the Office Action mailed July 2, 2002, process limitations cannot impart patentability to a product, which is not patentably distinguished over the prior art. Also, the argument presented by Applicants with regard to the particle size of the cyclodextrin product is not persuasive since the claimed particle size is well known in the art. The Majid et al patent explains that the size of the agglomerates can be varied by controlling the amount of water added and to a lesser degree the agitation, which suggests that the particle size limitation for the claimed cyclodextrin product of the instant claims is not novel. For example, see column 6, 5<sup>th</sup> paragraph of Mandell et al (US Patent No. 6,229,062), which is not used in the rejection of the claims, shows that cyclodextrins having particles sizes of about 25 to about 200 microns is well known in the art. Arguments presented in the above rejection of the claims over the Shah et al patent is incorporated in the arguments for the current rejection of the claims. Accordingly, the rejection of the claims as being unpatentable over the Majid et al patent in view of the Shah et al patent is maintained for the reasons of record.

### **Summary**

10. All the pending claims are rejected.

**Conclusion**

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner's Telephone Number, Fax Number, and Other Information**

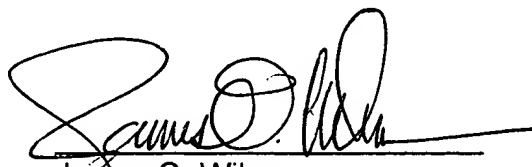
12. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White, *E. White*

  
James O. Wilson  
Supervisory Primary Examiner  
Technology Center 1600